

### **Remarks**

Independent claims 1, 9, 32 and 36 have been amendment to delete the lubricant and additional coupling agent recited as ingredients of the sizings of these claims, while new dependent claims 42-45 have been presented to add back these additional ingredients. In addition, new claims 46 and 47 have been presented to claim the particular bonding materials described at page 6, line 20 of the specification.

### **Informal Examiner Interview**

Applicants wish to thank the Examiner for the courteous informal telephonic interview conducted on October 8, 2010. Applicants believe that the interview helped to advance the prosecution of this application. During the informal interview, Applicants addressed the claim language of claims 1-3, 5-15, 17-19, 21-23, 25, 29-35, and 41. The Examiner clarified to Applicants' representative that a recitation of "roofing shingle" instead of "roof covering" in the claims would be sufficient to remove the rejection under 35 U.S.C. §112, first paragraph and should place the claims in condition for allowance.

### **Prior Art Issues**

Applicants submit that it is clear from the original claims, the working examples, and the statement of the invention contained in the Summary of the Invention section of the specification at page 1, line 18 to page 2, line 3, that a lubricant is not a mandatory ingredient of the sizing used in either embodiment of this invention. In addition, it is also clear from these portions of the original application that a separate coupling agent, in addition to the "sulfur-containing material" described at page 4, line 8 of the specification, is not a mandatory ingredient of the sizing used in the first embodiment of this invention described there. Similarly, it is also clear from these portions of the original application that a separate coupling agent, in addition to the "bonding material" described at page 6, line 5 of the specification, is not a mandatory ingredient of the sizing used in the second embodiment of this invention described there. Finally, it also seems clear from the Examiner's statement regarding why claims 1-3, 5-15, 17-19, 21-23, 25 and 29-31 are allowable over the prior art as set forth in Paragraph 2 on page 2 of the Office Action of January 25, 2010, that the presence or absence of this lubricant and additional coupling agent

in the sizings used in both embodiments of this invention played no role in the Examiner's decision that the claimed invention is patentable over the prior art. That being case, Applicants believe that these claims continue to be allowable over the prior art for the reasons of record, as persuasively set forth by the Examiner.

**Rejection under 35 U.S.C. 112, first paragraph**

Claims 1-3, 5-15, 17-19, 21-23, 25, 29-35, and 41 have been rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. In particular, the Examiner asserts that the rejected claims are directed to a roof covering "wherein the tear strength of the roof covering is increased by at least about 5% as measured by ASTM D 1922 compared to the same roof covering" without the various sulfur-containing materials in the sizing. However, it is asserted that the specification only provides support for a roof covering that is a roofing shingle where the tear strength of the roofing shingle is increased by at least 5% as measured by ASTM D 1922 compared to the same roofing shingle without the various sulfur-containing materials added.

**Applicants' Response**

Initially, Applicants submit that claims 5, 17, and 41 have been canceled without prejudice, thereby rendering the rejection of claims 5, 17, and 41 moot.

In response to this rejection, it is respectfully submitted that this rejection appeared for the first time in the Office Action of June 25, 2010, even though this limitation was added to these claims years earlier and even though numerous earlier office actions could have, but did not, make this rejection. This suggests that this rejection is an after-thought based on an unduly technical application of the written description requirement. More importantly, the first paragraph of MPEP §2163.04 makes clear that, whenever a written description rejection is made, the "Examiner has the initial burden of presenting by a preponderance of the evidence why a person skill in the art would not recognize in Applicant's disclosure a description of the invention defined the claims," citing *In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976).

In this case, the office action of June 25, 2010 is utterly devoid of any evidence regarding this issue, the office action merely stating that the limitation in question does not appear in the

original application as filed. But it is now well-accepted that new limitations added to patent claims need not be set forth in an original application *in haec verba* (in the exact same words) in order for the written description requirement to be satisfied. *See, for example, Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991) in which the Federal Circuit stated:

“Although the applicant does not have to describe exactly the subject matter claimed, ...the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The test for sufficiency of support in a patent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter.” (internal quotations and citations omitted) 935 F.2d at 1563

In this case, the Examiner’s explanation of the rationale underlying this rejection amounts to nothing more than an assertion that the limitation in question does not appear *in haec verba* in the original application as filed. This is not the type of evidence that MPEP §2163.04 contemplates for justifying a written description rejection. Indeed, this is not any type of evidence at all. Accordingly, not only is this rejection substantively improper, but in addition it is also procedurally improper, because the Examiner has failed to lay the necessary foundation to support this rejection as required by this section of the MPEP.

Third, and even more importantly, no experienced chemist skilled in the chemistry of roofing products would seriously consider Applicants not to have been in possession the invention recited in the rejected claims on the date this application was filed, Applicants believe. In particular, skilled roofing chemists would immediately recognize from Applicants original disclosure that achieving an increase in tear strength of at least 5% was fairly contemplated by Applicants, not only in connection with “roofing shingles” in particular but also with respect to all other “roof coverings” described in this application as well.

In this regard, it is important to note that the only difference described in this application between roofing shingles” one the one hand and “roof coverings” in general on the other hand is that the asphalt coating of the roofing shingles includes a “filler of finely divided ground inorganic particulate matter.” Page 3, line 25. In Applicants’ view, no skilled chemist in this field would believe that the increase in tear strength of 5% or more exhibited by “roofing shingles” made in accordance with this invention, as expressly mentioned at page 5 line 8 of the original application, would not also be exhibited by other inventive “roof coverings” not

including this inorganic particulate material. In particular, Applicants believe that no skilled roofing chemist would consider the presence of the types and amounts of particulate fillers used in roofing shingles to materially improve tear strength such that the absence of these particulate fillers would lead to a material decrease in tear strength. Certainly, the Examiner has not offered any such evidence. That being the case, persons of ordinary skill in this art would immediately understand from Applicants' original disclosure that an increase in tear strength of at least 5%, as expressly mentioned in connection with roofing shingles, would also be achieved in the other roof coverings described in this application as well. And this is especially so since the extent of the increase in tear strength mentioned at page 5, lines 6-14 of the original specification can be as much as 15% or more.

Applicants would also like to direct the Examiner's attention to MPEP §2163.05 I, which lays out in detail prior legal precedence relating to this issue. In Applicants' view, the present situation is not at all like that occurring in *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q. 1498 (Fed. Cir. 1998) in which the specification in question made clear that the feature embodied in the omitted limitation was the only way the invention would work and that variations from this feature "were outside the stated purpose of the invention." Rather, the present situation is much more akin to *In re Peters*, 723 F.2d 891, 221 U.S.P.Q. 952 (Fed. Cir. 1983) in which a limitation relating to the specific tapered shape of the tips was removed without violating the written description requirement, because the specification did not describe this tapered shape as being essential or critical to the operation of the patented device or its patentability over the prior art. *See, also, In re Rasmussen*, 650 F.2d 1212, 1214, 211 U.S.P.Q. 323, 326-327 (C.C.P.A. 1981); *In re Hershler*, 591 F.2d 693, 697 200 U.S.P.Q. 711, 714 (C.C.P.A. 1979); and *In re Smythe*, 480 F.2d 1376, 1383, 178 U.S.P.Q. 279, 285 (C.C.P.A. 1973), also discussed in MPEP §2163.05 I, which provide additional examples where the written description requirement was satisfied in a situation such as here in which a broadening amendment has been made.

Because the Examiner has provided no explanation or underlying rationale for this rejection, and because Applicants' original specification expressly indicates that the tear strength of all roof coverings disclosed in the application can be significantly improved by the invention of this application, persons of ordinary skill in this art would immediately recognize that the

minimum quantum of this increase (5%) as expressly described in connection with roofing shingles would also apply to all other roofing coverings disclosed in this application as well.

**Conclusion**

In light of the above, Applicants believe that this application is now in condition for allowance and therefore request favorable consideration.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 50-0568 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

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